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APPLICATION NO. 05/771,205	FILING DATE 10/02/00	FIRST NAMED INVENTOR RACHEL H. RONDINELLI	ATTORNEY, DOCKET NO. 100000000
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EXAMINER CHERRY
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ART UNIT 1247	PAPER NUMBER 20
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DATE MAILED:

12/12/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/716,209

Applicant(s)

Pradier et al.

Examiner

Stephen Tucker

Group Art Unit

1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/28/00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 27-28, 31-35, 37-38, & 40-54 is/are pending in the application.
- Of the above claim(s) 42-47 & 51-54 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 27-28, 31-35, 37-38, 40-41, & 48-50 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☒ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).
- \*Certified copies not received: FR 94/03191 filed March 18, 1994

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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*Response to Amendment*

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1647.
2. The request filed on 11/28/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/716,209 is acceptable and a CPA has been established. The Examiner notes that no preliminary amendment has been filed with the CPA request. An action on the CPA follows.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
5. Claims 42-47 and 51-54 were withdrawn in Paper No. 16, re-iterated in Paper No. 18 (see PTO-326) and in the restriction requirement.
6. Claims 27-28, 31-34, 37-38, 40-41, and 48-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a cDNA encoding BDNF (or a precursor protein) that is adequately characterized by chemical or structural characteristics, does not reasonably provide enablement for any substance or derivative that may be named "brain-derived neurotrophic factor" for reasons of record and the following. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected,

to make and use the invention commensurate in scope with these claims. The term "BDNF" carries no chemical or structural limitation to the recited chemical product, but only a functional limitation (neurotropism) and a source limitation (brain-derived). As such, the claims encompass any manner of substance that the brain produces that can be neurotrophic, such as neurotransmitters, adhesion molecules, even extracellular fluid (saline), etc. that are not envisioned by the instant specification. A protein's function cannot be adequately predicted from its amino acid structure, so any "derivative" of BDNF produced by adding, deleting, or substituting amino acids would be unpredictable in regards to the desired properties of BDNF. It is suggested that the BDNF encoded by the adenovirus vector of the instant claims recite some chemical or structural limitations to keep the breadth of the claims commensurate with the disclosure.

Applicant's arguments filed 8/24/98 have been fully considered but they are not persuasive because Applicant has not amended the claims to recite some chemical or structural limitations to keep the breadth of the claims commensurate with the disclosure.

Applicant's arguments filed 8/13/99 have been fully considered but they are not persuasive because Applicant argues limitations which are not in the claims, such as BDNF is an identified protein of 118 amino acids and a molecular weight of 13.5 kD, or is limited to the BDNF as described in Barde et al. (US 5,180,820). None of these limitations are recited in the instant claims.

7. Claims 27-28, 31-35, 37-38, 40-41, and 48-50 are rejected under 35 U.S.C. 103(a) as

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being unpatentable over Barde in view of Le Gal La Salle for reasons of record and the following. Barde discloses an adenovirus encoding human prepro/BDNF cDNA and transfected mammalian cells (column 18, line 32 to column 20, line 53, and column 38, line 7 to column 40, line 18). Barde did not teach specialized viral promoters for the nervous system or non-functional adenovirus E1 gene. Le Gal La Salle discloses replication deficient adenovirus vectors for gene transfer into neurons and glia that use RSV-LTR promoters and GFAP (page 988). Le Gal La Salle also had Michel Perricaudet as a co-author, who is also a co-inventor of the instant application. It is the Examiner's position that the replication deficient adenovirus of Le Gal La Salle had a non-functional E1 gene. The grounds of this rejection may be overcome by a 1.132 declaration by Michel Perricaudet that the Le Gal La Salle adenovirus had a functional E1 gene or other evidence (prior art) to the contrary. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the BDNF of Barde and the adenovirus techniques of Le Gal La Salle in order to treat diseases of the nervous system amenable to BDNF treatment as suggested by Barde.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Applicant's arguments filed 8/24/98 have been fully considered but they are not persuasive because Barde has a prior filing date of 8/30/89. Applicant has not perfected the foreign filing date sought of 9/25/92, so the Le Gal La Salle reference is still held as prior art (2/12/93).

Applicant's arguments filed 8/13/99 have been fully considered but they are not persuasive because Applicant's priority paper is not enabling for a replication defective recombinant adenovirus encoding BDNF because the disclosure is drawn to adenovirus encoding CNTF, HEXA, or NGF, but not BDNF.

8. Claims 27-28, 31-35, 37-38, 40-41, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barde in view of Wilson et al. (US 5,585,362). Barde discloses an adenovirus encoding human prepro/BDNF cDNA and transfected mammalian cells (column 18, line 32 to column 20, line 53, and column 38, line 7 to column 40, line 18). Barde did not teach specialized viral promoters for the nervous system or non-functional adenovirus E1 gene. Wilson teaches replication-defective adenovirus (abstract), RSV-LTR promoter, Ad 5 human adenovirus (column 11, lines 54-65) pfu/ml dosages (column 6, lines 25-55), and human cells from lung (column 8, lines 66-67). Wilson does not teach adenovirus comprising prepro/BDNF encoding cDNA. The effective date of Wilson is 9/11/92 (US Application No. 07/943,952). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make and use the replication-defective adenovirus of Wilson with the cDNA sequences taught by Barde in his replication defective retrovirus because Wilson discloses many advantages for the adenovirus vector for gene therapy, including its approval for clinical trials (column 2, lines 25-26), growth to extremely high titers for production purposes, usefulness in nondividing cells (column 2, lines 58-60), and other reasons (column 1, lines 54-62).

Applicant's arguments filed 8/13/99 have been fully considered but they are not persuasive

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because Applicant argues that Wilson does not have priority to 07/943,952 because US 5,240,846 and 5,625,128 are not enabling priority documents. This is unconvincing because '846 does not have priority back to 07/943,952. In addition, Wilson also claims priority to 07/401,609, 07/399,945, and 07/396,894. Furthermore, Applicant's priority paper is not enabling for a replication defective recombinant adenovirus encoding BDNF because the disclosure is drawn to adenovirus encoding CNTF, HEXA, or NGF, but not BDNF.

9. No claim is allowed.

10. This is a CPA of applicant's earlier Application No. 08/716,209. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of

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this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0830 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Stephen Gucker

December 5, 2000



GARY L. KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1000